

Atty. Dkt. No. 10012411-1

REMARKS

This Reply is in response to the Office Action mailed on November 29, 2005. Reconsideration and allowance of the pending claims is requested in view of the following remarks.

I. **Rejection of claims 13 and 15-19 under 35 USC § 102.**

Claims 13 and 15-19 stand rejected as being anticipated by U.S. Patent No. 5,607,275 to Woodruff. Applicant is amending claim 13 to recite that "the object comprises a toner cartridge...." Applicant submits that Woodruff does not disclose such a toner cartridge. Accordingly, Applicant submits that claim 13, as amended, is not anticipated by Woodruff. Withdrawal of the rejection of claim 13 is requested.

Claims 15-19 depend upon claim 13 and are allowable for at least the same reasons claim 13 is allowable. Withdrawal of this rejection is requested.

II. **Rejection of claims 1,3-8, and 10-12 under 35 USC § 103**

Claims 1, 3-8, and 10-12 stand rejected as unpatentable over Woodruff in view of Tianello. Applicant traverses this rejection.

The Office Action notes that "Woodruff et al. do not teach the hub as being a unitary structure." (Office Action, Page 4). The Office Action, however, also states that it "would have been obvious to one of ordinary skill in the art, at the time of invention to provide the device taught by Woodruff et al. with a unitary hub as taught by Tianello et al."

Applicant traverses this assertion on the basis that there is no suggestion or motivation to make the proposed modification. ("The prior art must suggest the desirability of the claimed invention." MPEP 2143.01(I)). In particular, Applicant submits that such a modification of the Woodruff device would render the Woodruff device unsatisfactory for its intended purpose. ("The proposed

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modification cannot render the prior art unsatisfactory for its intended purpose." MPEP 2143.01(V)). Consequently, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

Here, the Woodruff reference specifies that certain components are to have the capability to be selectively mountable or selectively secured. Modification of the Woodruff reference to make these components unitary renders Woodruff unsatisfactory for its intended purpose and, therefore, there is no suggestion or motivation to make the proposed modification.

To be more specific, the Woodruff et al. patent discloses a cartridge handling library 30 including a hub 34 having planar peripheral faces 52 (col. 3, line 64 - col. 4, line 15) with each hub peripheral face having "selectively mountable" thereon a rack holder plate or rack mount 110 for holding cartridge racks 60 (col. 5, lines 56-59). Rack mounts 110 of the Woodruff et al. patent, therefore, are "selectively" secured on hub 34 (col. 5, lines 61-64). As such, rack mounts 110 of the Woodruff et al. patent are not a unitary structure with hub 34. Modification of these rack mounts 110 to be unitary with hub 34, therefore, would result in these components not being "selectively" mountable or secured as intended by Woodruff. Hence, modifying the rack mounts 110 of Woodruff to be unitary with the hub 34 would destroy the selectively mountable feature of Woodruff. Hence, there is no suggestion or motivation to modify Woodruff as proposed in the Office Action.

Accordingly, because there is no motivation or suggestion to modify Woodruff with the teachings of Tianello, the Office Action does not establish a *prima facie* case of obviousness of claims 1, 3-8, and 10-12. Withdrawal of these rejections is requested.

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III. Conclusion.

Applicant believes that the present application is in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

Date

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